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ARENT FOX LLP				
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SUITE 400				
WASHINGTON, DC 20036				
EXAMINER				
WALSH, DANIEL I				
ART UNIT		PAPER NUMBER		
2887				
NOTIFICATION DATE		DELIVERY MODE		
09/16/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DCIPDocket@arentfox.com
IPMatters@arentfox.com
Patent_Mail@arentfox.com

Office Action Summary

Application No.

10/563,672

Applicant(s)

KATO ET AL.

Examiner

DANIEL WALSH

Art Unit

2887

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 January 2006 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/88)
Paper No(s)/Mail Date 1-6-06, 12-4-07, 6-5-08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Receipt is acknowledged of the Election of claims 1-3 without traverse received on 6-2-08.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Tanaka (US 20030116634).

Re claim 1, Tanaka (US 2003/0116634) teaches a circuit switchover part (12) provided on a surface of the card main body, a circuit (see FIG. 2) on a surface of the main body where continuity/discontinuity are switched by switching the switchover part, wherein the IC chip (4) is capable of transmitting to the reader (1) a signal corresponding to the continuity/discontinuity state of the circuit as stored information (11), as a signal corresponding to the state in which continuity is present, exists.

3. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Mine et al. (JP10302039) as cited by the Applicant.

Mine et al. teaches the claimed limitations through an IC card and conductive seal (FIG. 6-7), where tampering switches continuity.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Yoshiaki et al. (JP 200-194819), as cited by the Applicant.

5. Yoshiaki et al. teaches such claimed limitations (paragraph 0042-0048 and FIG 7-8) where removal of a layer, such as 27, results in a disconnection in the connection pattern being formed, thus interpreted as the switchover part.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(c), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chhatpar et al. (US 6805291).

Re claim 1, Chhatpar et al. (US 6805291) teaches a RFID type circuit/card with a chip and antenna in the body (abstract and inherent in wireless), information stored in the IC chip such as in the circuit 24 replacing the memory means 21, with a switchover part (61-63) for switching continuity/discontinuity states of the circuit in order to transmit to the reader a signal with the information. Though Chhatpar et al. teaches an RFID tag and not a IC card, the Examiner notes that both RFID tags and IC cards are used interchangeably in the art for wireless/contactless communication. Therefore, the selection of one or the other is an obvious expedient as a matter of design variation.

2. Claim 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chhatpar et al., as discussed above, in view of Bekers (US 4383461).

Re claims 2-3, Chhatpar et al. teaches the use of a pencil but is silent to a sticker or plurality of stickers. The Examiner has interpreted that each selection in Chhatpar et al. of an item can be interpreted as forming a unique circuit (path).

Bekers (US 4383461) teaches that lead pencils or electrically conductive stickers can be used to mark a card conductively.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Chhatpar et al. with those of Bekers.

One would have been motivated to do this to have additional ways to mark conductivity in addition to a pencil, such as using a sticker, thereby providing a more standardized means

(since pencil marks can vary in accuracy), and also providing ease of reproducibility, acceptability, and ease of use.

3. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bartels et al. (US 5159181) in view of Yoshiaki et al. (JP200194819), as cited by the Applicant.

Bartels et al. teaches a conductive pattern of a card (FIG. 1, 5) for data transmission.

Bartels is silent the limitations including the IC card structure.

Yoshiaki et al. teaches an IC card with an antenna chip storing information, reader, and transmitting to the reader the signal of the card (paragraphs [0042]-[0048] and FIG. 7-8.).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Bartels with those of Yoshiaki et al.

One would have been motivated to do this to provide such reliable results in an IC card environment.

6. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bartels/Yoshiaki et al., as discussed above, in view of Nagashima et al. (US 6436516).

The teachings of Bartels/Yoshiaki have been discussed above.

Bartels/Yoshiaki is silent to a conductive sticker/plurality of conductive stickers.

Nagashima et al. teaches such limitations (FIG. 4).

At the time the invention was made it would have been obvious to one of ordinary skill in the art to combine the teachings of Bartels/Yoshiaki et al. with Nagashima et al.

One would have been motivated to do this in order to have a simpler to produce means of effecting connections, via an sticker. Though silent to a plurality of stickers, as one sticker is taught, it would have been well within the ordinary skill in the art to use a plurality of stickers,

especially in instances where there would be breaks (FIG. 4 of Nagashima et al.) to therefore reduce size/cost of stickers and ensure proper placement.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (See PTO-892).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL WALSH whose telephone number is (571)272-2409. The examiner can normally be reached on M-F 9am-7pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Paik can be reached on 571-272-2404. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DANIEL WALSH/
Primary Examiner, Art Unit 2887

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